

10-23-02

OFFICIALExpedited Examining Procedure
Group 3761

PATENT

Docket No. 50142US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Joyce B. PALAZZOTTO et al.)	Group Art Unit:	3761
Serial No.:	10/067,141	Examiner:	A. Lewis
Confirmation No.:	7314		
Filed:	4 February 2002		
For:	SPEECH TRANSMISSION ADAPTOR FOR USE WITH A RESPIRATOR MASK		

RESPONSE UNDER 37 CFR §1.116

Assistant Commissioner for Patents

ATTN: BOX AF

Washington D.C. 20231

Dear Sir:

The Final Office Action mailed 22 July 2002 has been received and reviewed. No claims have been amended. Claims 1-20 are pending. Reconsideration and withdrawal of the rejections are respectfully requested for the reasons presented below.

The 35 U.S.C. §112, First Paragraph, Rejection

Claims 1-20 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully submit that this rejection is in error and cannot properly be sustained.

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When asserting a written description rejection, "the examiner has the initial burden of presenting evidence or reasoning to explain why one of skill in the art would not recognize in the original disclosure a description of the invention defined by the claims." *See*, MPEP § 2163(II)(A)(3)(b), P. 2100-165 (August 2001).

As support for this rejection the Examiner asserted that the language "... said spacer further having a microphone extending therefrom and into an interior of said face mask..." is not supported by the specification as originally filed. Applicants note, however, that the portion "and into an interior of said face mask" of that phrase does not appear in any of the claims of the present application.

In an attempt to provide additional support for the written description rejection, the Examiner analyzed Figures 5 and 6 of the present application and asserted that the present application cannot provide support for the phrase "a microphone extending therefrom" because the specification allegedly does not disclose a "microphone 20 extending THEREFROM AND INTO AN INTERIOR OF SAID FACE MASK." (Emphasis in the original). In other words, under the Examiner's interpretation, the phrase "a microphone extending therefrom" as it appears in the claims requires that the microphone also extend into an interior of the face mask. That interpretation is wrong because it reads a limitation into the claims that is not recited therein.

Applicants understand that "[w]hen interpretation of a claim that is copied for interference purposes, the copied claim is viewed in the context of the patent from which it was copied." *In re Spina*, 24 USPQ2d 1142, 1144 (Fed. Cir. 1992). Viewing the claims of the present application in the context of Birli et al., however, further supports Applicant's position that the Examiner's analysis of the claims is wrong and that this rejection cannot be sustained.

Claims 19 and 20 of Birli et al. both recite "a microphone extending therefrom and into an interior space of said face mask." Claims 1-18 of Birli et al. however, do not recite the limitation that the microphone also extend "into an interior space of said face mask." In other words, Birli et al. chose to include the limitation "and into an interior space of said face mask" in their claims 19 and 20, but not in claims 1-18.

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As a result, the Examiner's assertion that the limitation "a microphone extending therefrom" as it appears in the claims of the present application somehow implicitly requires that the microphone also extend "into an interior of said face mask" is not supported by a plain reading of the teachings and claims of Birli et al.

Because the written description rejection of claims 1-20 is based on limitations that do not appear in any of the rejected claims, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-20 under § 112, first paragraph.

Interference

Applicants submit that the Examiner's refusal to declare an interference in the present application with U.S. Patent No. 5,463,693 (Birli et al.) is also in error and cannot be maintained.

The refusal is primarily based on the Examiner's reading of the limitation that a microphone extend from the spacer "and into an interior of said face mask" into the claims. As pointed out above, however, that limitation does not appear in any of claims 1-20 in the present application.

Although the Examiner presented some analyses as to why dependent claims 7 and 16 and narrower independent claims 19 and 20 are not patentable to Applicants, we note that the refusal to declare an interference on the basis of all or any of claims 1-6, 8-15, 17, and 18 is premised solely on the erroneous written description rejection. Because that rejection cannot be sustained, an interference between the present application and Birli et al. must be declared.

Applicants note that this section of the Office Action also contains the following sentence: "The element recited in the claims of the instant application which may be readable upon the microphone of patent ('693) is '... speech reception means ...'." (*sic*). Applicants note however, that the language "speech reception means" is not recited in any of the claims of this application or Birli et al. Clarification as to the import of this statement is requested.

With respect to the specific claims addressed by the Examiner in this section, Applicants did identify support for those claims in the previous response and disagree that the identified

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claims are not patentable to Applicants. Applicants further reserve the right to more completely address the Examiner's assertions with respect to those claims at a later date if necessary.

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Summary

It is respectfully submitted that the pending claims 1-20 are in condition for allowance and notification to that effect is respectfully requested. It is further submitted that the pending claims support the declaration of an interference with U.S. Patent No. 5,463,693 to Birli et al. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
Joyce B. PALAZOTTO et al.

By
Mueiting, Raasch & Gebhardt, P.A.
P.O. Box 581415
Minneapolis, MN 55458-1415
Phone: (612) 305-1220
Facsimile: (612) 305-1228
Customer Number 26813

**26813**

PATENT TRADEMARK OFFICE

21 OCTOBER 2002
Date

By: KW Raasch
Kevin W. Raasch
Reg. No. 35,651
Direct Dial (612)305-1218

CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Attn: Box AF, Washington, D.C. 20231, on this 21st day of October, 2002, at 2:00 p.m. (Central Time).

By: Rachel Gagliardi-Grabau
Name: Rachel Gagliardi-Grabau